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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,396	07/19/2001	Norio Fukuda	P 027 7008 H7542US	9899

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EXAMINER

SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 11/13/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

CHO 10

**Office Action Summary**

Application No.

09/909,396

Applicant(s)

FUKUDA ET AL.

Examiner

John P. Sheehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 14 and 15 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8-13 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.                      6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112/101***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12, 13 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- I. Claims 12, 13 and 16 provide for the use of the claimed magnetostriction alloy sheet, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

3. Claims 12, 13 and 16 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 103***

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of Yasuhiro et al. (Yashiro, Japanese Patent Document NO. 04-228545, cited by the applicants in the IDS submitted November 25, 2002) or Norio et al. (Norio, Japanese Patent Document NO. 62-112759, cited by the applicants in the IDS submitted November 25, 2002).

Each of these references teaches specific examples of shadow mask materials having compositions that are encompassed by claim 2 (Yasuhiro, page 325, Table 1, Examples A, B and D to K, Table 3, Examples R to V and Norio, page 333, Table 1, Examples 1, 2, 6, 8, 11, 12, 14 to 16, 19, 20 and 24 to 26).

The references and claims differ in that the references are silent with respect to the magnetostriction of the disclosed alloys and do not teach that the alloy has been temper rolled.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the example alloys taught by the reference have compositions that are encompassed by the claims and therefore would be expected to possess all the same properties as recited in the instant claims. In re Best, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical

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or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)." (emphasis added by the Examiner), see MPEP 2112.01.

Regarding the limitation, "temper rolled", it is the Examiner's position that this language is a process limitation and that this process limitation recited in the instant product by process claims does not necessarily lend patentability to the claimed product, MPEP 2113.

6. Claims 3, 5, 10 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Norio et al. (Norio, Japanese Patent Document NO. 62-112759, cited by the applicants in the IDS submitted November 25, 2002).

Norio teaches and is applied as set forth above. Norio also teaches that the shadow mask material has a grain size number of 5 or greater. Norio teaches specific example alloys having compositions encompassed by applicants' disclosed alloy and which possess grain size numbers encompassed by the instant claims (see Norio, page 333, Table 1, Examples 1, 2, 6, 8, 11, 12, 14 to 16, 19, 20 and 24 to 26 and compare to the applicants' disclosed alloy composition page 3, lines 21 to 24 of the instant application).

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The claims and Norio differ in that Norio is silent with respect to the magnetostriction of the disclosed alloys.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the example alloys taught by the reference have compositions that are encompassed by applicants' disclosed alloy composition and grain size numbers that are encompassed by applicants' claims and therefore would be expected to possess all the same properties as recited in the instant claims, including the claimed magnetostriction, *In re Best*, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' *In re Spada*, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977)." (emphasis added by the Examiner), see MPEP 2112.01.

### ***Allowable Subject Matter***

1. Claims 4, 14 and 15 are allowed.
2. The following is a statement of reasons for the indication of allowable subject matter: None of the references alone or in combination teach or suggest an alloy sheet having a magnetostriction of between  $(-15 \times 10^{-6})$  and  $(25 \times 10^{-6})$  after having been

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subjected to softening and annealing and wherein "the {100} degree of accumulation on the rolled surface is 40 to 90%".

### ***Response to Arguments***

3. Applicant's arguments filed August 29, 2003 have been fully considered but they are not persuasive.

Applicants' argument that the references do not teach that the disclosed alloy "being a temper rolled alloy sheet" is not persuasive. It is the Examiner's position that the claim language, "being a temper rolled alloy sheet" is a process limitation and that this process limitation recited in the instant product by process claims does not necessarily lend patentability to the claimed product, MPEP 2113.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
John P. Sheehan  
Primary Examiner  
Art Unit 1742

jps  
November 7, 2003